REMARKS

Reconsideration of the application is respectfully requested in view of the amendments and the discussion presented below. The amendments are supported by the application as filed and no new matter has been added by any of the amendments.

Claims 1, 11, 14, and 18 have been amended as discussed below.

The specification before the claims has been amended to include headings.

Claims 1-14 and 18 are now present in this application.

Discussion

A   The Objection to the Specification

The Examiner objected to the 'disclosure" because it did not include headings such as "Summary" and the like. The specification has been amended to include these headings. It is respectfully submitted that the objection to the specification therefore should be withdrawn.

B.   The Objection to Claim 1

The Examiner objected to claim 1 because of an alleged informality in referring to "the or each binding element such that . . .."

Claim 1 has been amended to recite "in which the step of authoring the layout document includes allocating to the at least one defined area a director to at least one binding element such that when processed the published document includes in the defined area the content as directed by the binding element in the style as directed by the binding element." The language "binding document of the or each" has been deleted from this limitation. It is respectfully submitted that the objection to claim 1 therefore should be withdrawn.

Although not required by the Examiner, claims 11, 14, and 18 have also been amended to remove informalities of the kind noted by the Examiner in connection with claim 1.

C.   The Rejection of Claims 1-10 under 35 USC 101

The Examiner rejected claims 1-10 under 35 USC 101 as being directed to non-statutory subject matter "because the claims describe a method that doesn't have to be performed using a computer." The Examiner stated that the method recited in claims 1-10 should be associated to a computer or tangible element. The Examiner is thanked for this suggestion and claim 1 has been amended to recite that it is directed to a "method of authoring content to be served <u>by a server</u>" and that the steps comprise "authoring on a computing device."

It is respectfully submitted that the 35 USC 101 rejection of claim 1 should be withdrawn. Claims 2-10 depend from claim 1 and therefore the 35 USC 101 rejection of those claims should be withdrawn as well.

D.   The Rejection of Claims 11-14 under 35 USC 101

The Examiner rejected claims 11-14 under 35 USC 101 as being directed to non-statutory subject matter because "they describe a data structure but fail to include the association of a computer readable medium" and "no steps or processes using the data structure are performed."

Claim 11 has been amended to recite that the data structure is "embodied in a computer-readable medium" and "whereby the data structure may be rendered on a device receiving the data structure from the server." Claim 14 has been amended likewise. Claims 12 and 13 depend from claim 11 directly or indirectly.

It is respectfully submitted that the 35 USC 101 rejection of claim 11-14 should be withdrawn.

E.   The Rejection of Claims 1-3, 7, 8, 10-14, and 18 as being Anticipated by Ferrel

The Examiner rejected claims 1-3, 7, 8, 10-14, and 18 under 35 USC 102(e) as being anticipated by U.S. patent 6,199,082 to Ferrel ("Ferrel"). The Applicant respectfully disagrees, as explained below in connection with particular claims.

Claim 1

Claim 1, as amended, requires the step of "authoring on a computing device at least one binding element which defines the identity and location of at least a portion of content and at least

one style description which defines a style to be applied to a selected portion of content." This step is not taught or suggested by Ferrel.

The Examiner cited to Ferrel at Figure 5 and column 19, lines 38-51 and column 8, lines 10-65 as teaching an "object" that represents the claimed binding element.

The "object" taught by Ferrel, however, is defined as "a discrete data item or data structure which can be stored in persistent storage or in memory." *Id.* at column 8, lines 18-21. Furthermore, the "content and the design are stored as separate objects in the public distribution site so that many different pieces of content may be viewed with the same appearance." *Id.* at column 8, lines 15-18. The design is stored as "layout objects such as pages, styles, and search objects" that are created in state 328 of Figure 5 of Ferrel. *Id.* at column 18, lines 46-49. The layout objects such as styles are referenced by controls such as picture controls and story controls associated with a page, in order to provide formatting instructions on how the content I to be displayed. *Id.* at column 21, lines 50-53.

Objects such as story objects, when authored, are "given formatting tags that represent specific styles" so that when "the story objects are rendered, they reference the style sheet that is linked to the appropriate control to retrieve formatting information" although "[d]ue to the separation of design and content in the MP system, the story objects themselves have only formatting tags, but do not contain a description of the particular format that corresponds to each tag." *Id.* at column 22, lines 13-25.

Ferrel, therefore, discloses content objects that contain style/formatting information in the form of formatting tags, and layout objects that include style sheets and other design elements.

Ferrel contains no disclosure of "authoring on a computing device at least one binding element which defines the identity and location of at least a portion of content and at least one style description which defines a style to be applied to a selected portion of content." The objects taught by Ferrel are clearly not "binding elements" as claimed because they are the content or the style data themselves. They are not an element defining the "identity and location of at least a portion of content and at least one style description which defines a style to be applied to a selected portion of content."

Because Ferrel does not disclose the step of "authoring on a computing device at least one binding element," Ferrel does not disclose the claimed limitation "in which the step of authoring the layout document includes allocating to the at least one defined area a director to at least one binding

element such that when processed the published document includes in the defined area the content as directed by the binding element in the style as directed by the binding element." The Examiner cites column 10, lines 1-30 as teaching this disclosure. This section of Ferrell teaches placing controls on a blank page layout. *Id.* at column 10, lines 12-15. As discussed above, however, it contains no mention of "binding elements" and does not teach or suggest "allocating to the at least one defined area a director to at least one binding element [etc.]."

In general, the Examiner believes that Ferrel "teaches a publishing system for separating content from format" (see page 7 of the office action). While Ferrel does state that a benefit of his system is that content is published separately from the layout (column 5, lines 3-4), Ferrel does not teach or suggest the limitations of claim 1.

To anticipate a claim, the reference must teach every element of the claim and the elements in the reference must be arranged as required by the claim. M.P.E.P. § 2131. Ferrel does not teach or suggest at least the limitations quoted from claim 1. The Section 102(e) rejection of this claim over the Ferrel reference should be withdrawn for at least this reason.

Claim 11

Independent claim 11 is directed to a data structure that is suitable for processing by a server for serving as a document. The claim contains a "binding element" limitation and the allocation of at least one binding element to at least one of the areas of the document. Ferrel does not anticipate claim 11 for at least the reasons given above in connection with claim 1.

Claim 14

Independent claim 14 is directed to a data structure embodied in a computer-readable medium that is suitable for programming a processor of a computing device to author servable content. The claim contains a "binding element" limitation and "authoring the layout document includes allocating to the at least one defined area a director to at least one binding element such that when processed the published document includes in the defined area the content as directed by the binding element in the style as directed by the binding element." Ferrel does not anticipate claim 14 for at least the reasons given above with respect to claim 1.

Claim 18

Claim 18 is directed to a system for authoring content to be served. The claim contains a "binding element" limitation and the "layout document processor is arranged to allocate to the at least one defined area a director to at least one binding element such that when processed the published document includes in the defined area the content as directed by the binding element in the style as directed by the binding element." Ferrel does not anticipate claim 18 for at least the reasons given above with respect to claim 1.

Claims 2, 3, 7, 8, 10, 12, and 13

Claims 2, 3, 7, 8, 10, 12, and 13 depend directly or indirectly on independent claims 1 or 11 and are allowable over Ferrel for at least that reason.

F.   The Rejection of Claims 4-6 and 9 as Being Unpatentable over Ferrel in view of Brauer

Claims 4-6 and 9 were rejected under 35 USC 103(a) as being unpatentable over Ferrel in view of U.S. patent publication 2001/0014900 to Brauer ("Brauer"). The Applicant respectfully disagrees.

The Applicant submits that the Examiner has **not** established a *prima facie* case of obviousness for the claims rejected under 35 U.S.C. §103(a). The criteria for a *"prima facie* case of obviousness"* are as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.**

> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991)

MPEP at § 2143 (emphasis added). The Applicant submits that a *prima facie* case of obviousness has not been established because the Examiner has failed to show that Ferrel and Brauer teach each and every element as claimed in the present application.

In particular, claims 4-6 and 9 depend directly or indirectly from claim 1. As noted above, Ferrel does not teach or suggest the "authoring at least one binding element" or the "allocating to the at least one defined area a director to at least one binding element" steps of claim 1 that are incorporated in claims 4-6 and 9.

Brauer is cited for teaching a "file compris[ing] a section of data written for example in a mark-up language such as XML" and therefore providing an "XML representation of a computer readable document" because "Ferrel fails to explicitly teach the use of XML for representing the data." Brauer therefore is not cited for teaching of the "authoring at least one binding element" or the "allocating to the at least one defined area a director to at least one binding element" steps of claim 1. The combination of Ferrel and Brauer, even were the Examiner's cited motivation ("for the benefits of allowing representation of content and style using XML allowing easier modification to the elements") to be conceded *arguendo*, does not teach or suggest the claimed subject matter.

The Section 103(a) rejection of claims 4-6 and 9 should be withdrawn.

Conclusion

Claims 1-14 and 18 are allowable because the rejections over Sections 102(e) and 103(a) and the objections to the claims and the specification have been overcome as described above.

In view of the above, the Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue. The Examiner is invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

* * *

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time

period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months

necessary to make this response timely filed and the petition fee due in connection therewith may be

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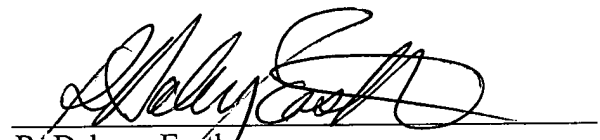
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